

REMARKS/ARGUMENTS

The Office Action dated June 15, 2004 has been received and its contents carefully considered. Claims 1-20 are pending. Claims 1-20 have been rejected. Claim 8 has been amended. Claim 21 has been added. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

CLAIM OBJECTIONS

Claim 6 was objected to because of a duplicate claim. Claim 6 (second occurrence) has been cancelled and the subject matter thereof has been incorporated into newly added claim 21. It is believed that all claims are in compliance.

CLAIM REJECTIONS – 35 U.S.C. § 102(b)

Claims 1-5, 8-12, and 15-19 were rejected under 35 U.S.C. §102(b) as being anticipated by *Gibson, et al.* (U.S. Patent No. 5,530,373). It is respectfully submitted that *Gibson, et al.* does not teach, *inter alia*, a digital multimeter adaptor for a portable electronic device comprising a module adapted to interface with a hardware interface port, “the module including a computer programmed memory, the memory storing computer programming instructions thereon to direct the processor” as recited in claim 1. It is further submitted that *Gibson, et al.*, does not teach, *inter alia*, a method of causing an electronic device to function as a digital multimeter comprising “connecting an adapter module to a hardware interface port of a portable electronic device... delivering computer programming instructions from the module to the processor” as recited in claim 8. It is also respectfully submitted that *Gibson, et al.* does not teach, *inter alia*, a plug in module for a portable electronic device comprising “a means for interfacing with an

electronic device... a computer program memory, the memory storing computer programming instructions thereon to direct a processor” as recited in claim 15.

Gibson, et al. merely teaches an electronic test instrument without an additional module adapted to interface with a test instrument to provide additional functionality as recited in the claims of the present invention. The Examiner states that the DUT 14 is a module. However, upon further review of the *Gibson, et al.* reference, the device under test (DUT) 14 is utilized as an object for which the electronic test instrument 10 is testing (see column 5, lines 40-46). The DUT 14 cannot be regarded as a module as recited in claims 1, 8 and 15 of the present invention. Furthermore, *Gibson, et al.* is silent with regards to teaching a module including a computer program memory for storing computer programming instructions to further direct the processor of an electronic device to perform additional steps as claimed by the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, *Gibson, et al.* cannot be said to anticipate the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-5 depend ultimately from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 9-12 depend ultimately from independent claim 8 and are patentable over the cited prior art for at least the same reasons as is claim 8.

Claims 16-19 depend ultimately from independent claim 15 and are patentable over the cited prior art for at least the same reasons as is claim 15.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 6, 7, 13, 14 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Gibson, et al.* in view of *Gibson* (U.S. Patent No. 5,508,607).

Claims 6-7 depend ultimately from independent claim 1. Claims 13-14 depend ultimately from independent claim 8. Claim 20 depends from independent claim 15. *Gibson, et al.* fails to teach the invention as recited in claims 1, 8 and 15 as outlined above. *Gibson* does not cure the deficiencies of *Gibson, et al.*, because it, too, fails to teach a module adapter to interface with a hardware interface port of a portable electronic device including a computer programmed memory which stores computer program instructions to direct the processor of the electronic device to perform additional steps as recited in claim 1 and similarly in claims 8 and 15 of the present invention.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all the claimed features, *Gibson, et al.*, alone or in combination with *Gibson*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Newly added claim 21 depends ultimately from independent claim 1 and is patentable over the cited prior art for at least the same reasons as is claim 1.

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Patent

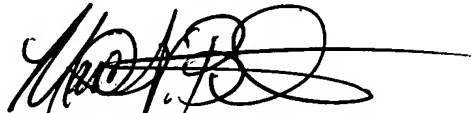
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. **Please charge an additional claim fee in the amount of \$18.00 to Deposit Account No. 50-2036.**

Respectfully submitted,

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